

**Response to Office Action Mailed April 8, 2003**

**A. Claims In The Case**

Claims 1-40 have been rejected. Claims 1-40 have been cancelled. Claims 41-70 are pending in the case.

**B. Information Disclosure Statement**

In the Office Action dated April 8, 2003, the Examiner stated that the information disclosure statement filed on March 4, 2003 failed to comply with 37 CFR 1.97(c) because it lacked the fee set forth in 37 CFR 1.17(p). The Examiner further stated that the information disclosure statement had been placed in the application file, but that the information referred to therein had not been considered. However, the Office Action was accompanied by copies of the Electronic Information Disclosure Statement and PTO-1449 which included the Examiner's initials indicating that the references had been considered. Applicant respectfully submits that a fee authorization in the amount of \$180 for submission of the information disclosure statement accompanied the electronic portion of the information disclosure statement. A copy of the electronic acknowledgement receipt generated by the Patent Office showing the fee authorization, a copy of the fee authorization and a deposit account statement are included as attachments to this response to demonstrate the proper payment of the fee. The Examiner is respectfully requested inform the Applicant of the actual status of the information disclosure statement, and to consider the references therein.

**C. The Claims Are Not Obvious Over The Cited Art Pursuant To 35 U.S.C. § 103(a)**

The Examiner has rejected claims 1-40 as being unpatentable over U.S. Patent No. 6,272,482 to McKee et al. (hereinafter "McKee") in view of U.S. Patent No. 5,613,072 to Hammond et al. (hereinafter "Hammond"). Applicant respectfully disagrees with these rejections; however, to expedite prosecution of the case, claims 1-40 have been cancelled. Claims 41-70 have been added. Support for the new claims is found in the specification and claims as originally filed. Patentability of the new claims is discussed below.

New independent claim 41 states:

A system comprising:

- a database comprising a plurality of business rule data elements;
- a translator program configured to read two or more business rule data elements from the database and to combine two or more business rule data elements to form at least one business rule; and
- a rules engine configured to assess a value of an insurance claim as a function of at least one business rule formed by the translator program. (claim 41)

Applicant respectfully submits that neither McKee, nor Hammond, alone or in combination, appears to teach or suggest the combination of features of claim 41, including but not limited to a "translator program configured to read two or more business rule data elements from a database and to combine two or more business rule data elements to form a business rule". This feature of claim 41 includes some portions which are similar to features of claim 2 (now cancelled). In rejecting claim 2, the Examiner stated that, "McKee discloses the system further comprising a translator program which is operable to read said rules data from said database and transform said rules data into said plurality of rules for use by said rules engine (Col. 7, lines 5-26)." (Office Action, p. 3, paragraph (B)). The cited portion of McKee, states:

Communication between processing system 20 and other data processing systems may be facilitated by serial controller 88 and network adapter 90, both of which are coupled to system bus 5. Serial controller 88 is used to transmit information between computers, or between a computer and peripheral devices, one bit at a time over a single line. Serial communications can be synchronous (controlled by some standard such as a clock) or asynchronous (managed by the exchange of

control signals that govern the flow of information). Examples of serial communication standards include RS-232 interface and the RS-422 interface. As illustrated, such a serial interface may be used to communicate with modem 92. A modem is a communication device that enables a computer to transmit information over standard telephone lines. Modems convert digital computer signals to interlock signals suitable for communications over telephone lines. Modem 92 can be utilized to connect data processing system 20 to an on-line information service or an Internet service provider. Such service providers may offer software that can be down loaded into data processing system 20 via modem 92. Modem 92 may provide a connection to other sources of software, such as a server, an electronic bulletin board (BBS), or the Internet. (McKee, col. 7. lines 5-26)

The cited portion of McKee appears to be directed to general concepts of computer communications. However, the cited portion of McKee (as well as the rest of McKee) does not appear to teach or suggest a translation program which is configured to read two or more business rule data elements from a database and to combine two or more business rule data elements to form at least one business rule. For example, with regard to the translation program, the Specification of the present application states:

Other types of tables stored in the database 40, in one embodiment, may include a LineText table as shown by way of example in Figure 3c and a Template table as shown by way of example in Figure 3b. The LineText table may store lines or other elements of text which may be used to generate the rules. The Template table may include information which may be used by the application program to read each row of data from the rules data table and transform, create or generate the rules data into a rule. In one embodiment, every rule style may have an entry in the Template table. The location to store the transformed rule, the name of the rules data table, the name of the rule style, an identifier for the line text, etc. may also be included in the Template table, in one embodiment. (Specification, p. 15, lines 4-13).

In step 140, data entries in each column of the rules data table are used to transform, create, or construct the rules. Entries for columns like rules style and rules name in the rules data table may be used as a key to find a matching record in the Template table. Other data stored in the columns of the rules data may be used to build the rule premise and/or the resulting one or more rules action.

(Specification, p. 15, lines 22-26).

Hammond also does not appear to teach or suggest the features of the translation program. For at least the reasons discussed above, Applicant respectfully submits that claim 41, and claims dependent thereon (i.e., claims 42-46) are patentable over the cited art.

New independent claims 47 and 59 include the features of:

- providing a plurality of business rule data elements in a memory of a computer system, wherein two or more of the business rule data elements are combinable to form at least one business rule;

- combining two or more business rule data elements of the plurality of business rule data elements to form at least one business rule for processing an insurance claim; and

- providing at least one formed business rule to a rules engine, wherein at least one formed business rule is executable by the rules engine to process at least one insurance claim.

The Examiner has not shown that either McKee or Hammond, alone or in combination, includes the features of new independent claims 47 and 59. For example, the feature of combining two or more business rule data elements of the plurality of business rule data elements to form at least one business rule for processing an insurance claim does not appear to be taught or suggested in either McKee or Hammond, alone or in combination. For at least the reasons discussed above, Applicant respectfully submits that claims 47 and 59, and claims dependent thereon (i.e., claims 48-58 and 60-70) are patentable over the cited art.

**D. Many Of The Dependent Claims Are Separately Patentable**

The Examiner is also respectfully requested to separately consider each of the dependent claims for patentability. Many of the dependent claims in addition to those mentioned above are independently patentable.

For example, new claim 45 states, “wherein at least one business rule comprises a premise and one or more resulting actions for assessing the value of the insurance claim.” Claims 53 and 65 include a similar feature. Neither McKee nor Hammond, alone or in combination, appears to teach or suggest a business rule including a premise and one or more resulting actions for assessing the value of an insurance claim.

In another example, new claims 55 and 67 state in part, “modifying at least one business rule data element in the memory and combining at least two business rule data element, including at least one modified business rule data element, to form at least one modified business rule.” Neither McKee nor Hammond, alone or in combination, appears to teach or suggest modifying business rule data elements and combining business rule data elements ( including at least one modified business rule data element) to form a modified business rule.

**E. Response to Arguments**

In the “Response to Arguments” portion of the Office Action, the Examiner states that “obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments.” Applicant respectfully submits that the Examiner has not provided in this statement a complete definition of the requirement for demonstrating obviousness. For example, the Manual of Patent Examination Procedures (MPEP) provides three basic criteria that must be met to establish prima facie obviousness. Specifically, referring to MPEP 2143, the MPEP states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (MPEP 2143, emphasis added)

Applicant respectfully submits that the Examiner has not met the basic requirements to establish a prima facie case of obviousness in either the first Office Action, dated October 8, 2002, or in the second Office Action, dated April 8, 2003.

**F. Summary**

Based on the above, Applicant submits that all claims are in condition for allowance. Favorable reconsideration is respectfully requested.

in the Template table. Other data stored in the columns of the rules data may be used to build the rule premise and/or the resulting one or more rules action. (Specification, p. 15, lines 22-26).

Hammond also does not appear to teach or suggest the features of the translation program. For at least the reasons discussed above, Applicant respectfully submits that claim 41, and claims dependent thereon (i.e., claims 42-46) are patentable over the cited art.

New independent claims 47 and 59 include the features of:

- providing a plurality of business rule data elements in a memory of a computer system, wherein two or more of the business rule data elements are combinable to form at least one business rule;

- combining two or more business rule data elements of the plurality of business rule data elements to form at least one business rule for processing an insurance claim; and

- providing at least one formed business rule to a rules engine, wherein at least one formed business rule is executable by the rules engine to process at least one insurance claim.

The Examiner has not shown that either McKee or Hammond, alone or in combination, includes the features of new independent claims 47 and 59. For example, the feature of combining two or more business rule data elements of the plurality of business rule data elements to form at least one business rule for processing an insurance claim does not appear to be taught or suggested in either McKee or Hammond, alone or in combination. For at least the reasons discussed above, Applicant respectfully submits that claims 47 and 59, and claims dependent thereon (i.e., claims 48-58 and 60-70) are patentable over the cited art.

**D. Many Of The Dependent Claims Are Separately Patentable**

The Examiner is also respectfully requested to separately consider each of the dependent claims for patentability. Many of the dependent claims in addition to those mentioned above are independently patentable.

For example, new claim 45 states, “wherein at least one business rule comprises a premise and one or more resulting actions for assessing the value of the insurance claim.” Claims 53 and 65 include a similar feature. Neither McKee nor Hammond, alone or in combination, appears to teach or suggest a business rule including a premise and one or more resulting actions for assessing the value of an insurance claim.

In another example, new claims 55 and 67 state in part, “modifying at least one business rule data element in the memory and combining at least two business rule data element, including at least one modified business rule data element, to form at least one modified business rule.” Neither McKee nor Hammond, alone or in combination, appears to teach or suggest modifying business rule data elements and combining business rule data elements ( including at least one modified business rule data element) to form a modified business rule.

**E. Response to Arguments**

In the “Response to Arguments” portion of the Office Action, the Examiner states that “obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments.” Applicant respectfully submits that the Examiner has not provided in this statement a complete definition of the requirement for demonstrating obviousness. For example, the Manual of Patent Examination Procedures (MPEP) provides three basic criteria that must be met to establish prima facie obviousness. Specifically, referring to MPEP 2143, the MPEP states:



To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (MPEP 2143, emphasis added)

Applicant respectfully submits that the Examiner has not met the basic requirements to establish a *prima facie* case of obviousness in either the first Office Action, dated October 8, 2002, or in the second Office Action, dated April 8, 2003.

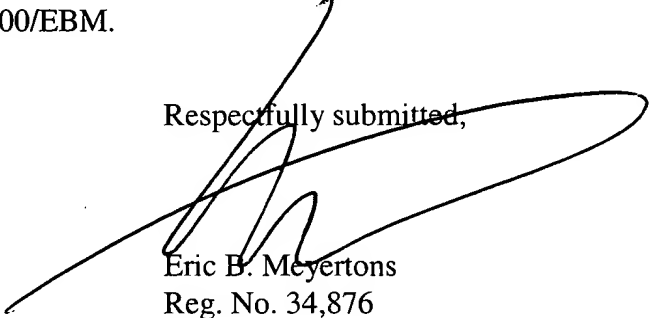
**F. Summary**

Based on the above, Applicant submits that all claims are in condition for allowance. Favorable reconsideration is respectfully requested.

Jones et al.  
09/603,144

It is believed that no fees are due in connection with the filing of this Amendment and Response to Office Action. If any extension of time is required, Applicant hereby requests the appropriate extension of time. If any fees are inadvertently omitted or if any additional fees are required, please charge those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5053-28000/EBM.

Respectfully submitted,



Eric B. Meyertons  
Reg. No. 34,876

Attorney for Applicant

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.  
P.O. BOX 398  
AUSTIN, TX 78767-0398  
(512) 853-8888 (voice)  
(512) 853-8801 (facsimile)

Date: 7-8-03